

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Swart, et al.

Serial No.: 09/973,067

Confirmation No.: 5257

Filed: October 10, 2001

For: VIDEO AND DIGITAL
MULTIMEDIA AGGREGATOR CONTENT
CODING AND FORMATTING

§ Case Number: SEDN/12164
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§ Group Art Unit: 2623
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§ Examiner: Saltarelli, Dominic D.
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MAIL STOP – Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir or Madam:

REPLY BRIEF

Appellants submit this Reply Brief to the Board of Patent Appeals and Interferences in response to the Examiner's Answer dated October 24, 2008 in the Appeal of the above-identified application.

The Commissioner is authorized to charge any fees due, including extension of time and excess claim fees, to counsel's Deposit Account No. 20-0782/SEDN/12164.

REMARKS

In Section 10 of The Examiner's Answer (Response to Arguments), the Examiner emphasizes the fact that the "one and only feature upon which Hendricks is silent is that said instructions originate from a user," which in turn the Examiner relies upon Smith.

The Appellants respectfully submit that the MPEP § 2141.02(VI) requires the Examiner to consider the prior art in its entirety. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention". MPEP § 2141.02(VI), W.L. Gore & Associates, Inc., v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed Cir. 1983), cert. denied, 469 U.S. 851 (1984), (emphasis added). In addition, it is impermissible to use the claims as a framework from which to choose among individual references to recreate the claimed invention. W. L. Gore Associates, Inc. v. Garlock, Inc., 220 U.S.P.Q. 303, 312 (1983).

The Examiner appears to use the fact that a request is received from a user in Smith in isolation apart from the remaining teachings of Smith. As highlighted in the Appellants' appeal brief submitted on September 2, 2008, Smith only teaches that information is requested and a comparator determines if the information requested and the information destination are compatible. (See Smith, col. 5, I. 41- col. 6, I. 7; Appellants' Appeal Brief, p. 13). Thus, at best Smith only appears to teach that a user requests information and not a coding and formatting request in one of at least two different formats from a user.

The Appellants' contend that simply finding any references teaching where a user requests something is not sufficient to establish a *prima facie* case of obviousness in combination with Hendricks. As noted above and in the Appellants' appeal brief, considering Smith in its entirety would only teach that a user may request information and if the information is compatible the information may be received. (See Smith, col. 5, I. 41 – col. 6, I. 7; col. 6, II. 43-55).

Furthermore, Hendricks fails to teach or suggest receiving a coding and formatting request in one of at least two different formats from a user. Rather, the sections cited by the Examiner refer to an exemplary architecture of an operations center 202. The type of signal outputted by the hardware in the output equipment 320 is determined by the destination of the signal. (See Hendricks, col. 14, I. 21 – col. 15, I.

46; FIGs. 2-5). Thus, if a user is on an ATM network, the user does not have a choice as to the formatting of the received program. In other words, a subscriber on an ATM network will receive programs in an ATM signal. Consequently, even if Hendricks and Smith were combined, the combination would still fail to teach or suggest receiving a coding and formatting request in one of at least two different formats from a user.

Therefore, the Appellants contend that the Examiner failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. Therefore, the Appellants respectfully request the Board to reverse the Examiner's rejection of all claims.

CONCLUSION

Appellants respectfully request that the Board reverse the rejections and pass the claims to allowance.

Respectfully submitted,

12/24/05



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